



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
YIQING ZHOU ET AL. :
Serial No. 08/043,998 :
Filed April 7, 1993 : Group Art Unit 1205 ✓
ANTIMALARIAL COMPOSITIONS : Examiner K. Jordan

PRELIMINARY RESPONSE

Honorable Commissioner of Patents and Trademarks
Washington, D.C.

Sir:

The instant paper is presented prior to an examination on the merits of the above-identified application. This paper is presented in an effort to advance the prosecution of the application and in a sincere effort to place the application in immediate condition for allowance.

In the Official Action dated December 7, 1992 in Applicants' parent application Serial No. 07/714,229, the Examiner rejected claims 20 to 23 as failing to adequately define the invention under the provisions of 35 U.S.C. 112.

In response to that Official Action, claims 20 and 21 were cancelled and arguments were presented to establish that the Examiner's rejection was untenable insofar as claims 22 and 23 were concerned.

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In the Advisory Action issued March 17, 1993 in the parent application, the Examiner appears to have withdrawn the rejection of claims 22 and 23 as failing to adequately define the invention.

The issue thus remaining in the present application is that of the patentability of the claims over Wang et al. (R) and Sethi et al. (S).

As to this rejection, the attention of the Examiner is directed to the arguments of the Applicants in the AMENDMENT AFTER FINAL REJECTION filed March 5, 1993. Those arguments are incorporated herein by reference.

As the Examiner will appreciate, Applicants have relied upon the Declaration of Dr. Walther H. Wernsdorfer to overcome any presumption of obviousness of the instantly claimed subject matter which can be said to be raised by the teachings of the references upon which the Examiner relies. The Examiner has refused to recognize the Declaration as constituting sufficient evidence to establish patentability. The criticism of the Examiner is based upon the use of the geometric mean approach in the Declaration. Thus, in the Advisory Action issued by the Examiner in the parent application, the Examiner states:

"The use of the geometric mean approach has not been shown to be valid by a significant number of ordinarily skilled workers in this area of technology."

In order to overcome the position advanced by the Examiner, Applicants are submitting herewith a new Declaration of Dr. Wernsdorfer. As an initial point, it is noted that this Declaration is headed in the parent application. At the time

of the preparation of the new Declaration, the serial number for the present application was not yet available to the Applicants. This does not, however, detract from the pertinency and persuasiveness of the Declaration.


The Declaration is identical with the Declaration of Dr. Wernsdorfer previously presented with the exception that the new Declaration contains the additional paragraph at lines 3 to 8 from the bottom on page 4 of the Declaration. In that paragraph, Dr. Wernsdorfer - an imminent expert in the art to which the present invention relates - states that the calculation methods applied by him to arrive at the expected values are correct and appropriate. It is respectfully submitted that this statement by this expert in the art is clearly sufficient to overcome the objection raised by the Examiner in the Advisory Action issued in the parent application.

Thus, it is submitted that the Examiner's rejection of the claims of the present application as being unpatentable over the prior art is overcome and that the application is in condition for allowance; such allowance is solicited.

Respectfully submitted,

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By:


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June 9, 1993